

ESTTA Tracking number: **ESTTA321858**

Filing date: **12/14/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Zink Imaging, Inc.
Granted to Date of previous extension	12/13/2009
Address	16 Crosby Drive Bedford, MA 10730 UNITED STATES
Attorney information	Lee J. Eulgen Neal Gerber & Eisenberg LLP Two North LaSalle St.Suite 1700 Chicago, IL 60602 UNITED STATES mhoffman@ngelaw.com

### Applicant Information

Application No	77566527	Publication date	06/16/2009
Opposition Filing Date	12/14/2009	Opposition Period Ends	12/13/2009
Applicant	Scholastic Inc. 557 Broadway New York, NY 10012 UNITED STATES		

### Goods/Services Affected by Opposition


Class 016. First Use: 2008/08/11 First Use In Commerce: 2008/08/11 All goods and services in the class are opposed, namely: Series of books for children in the field of music; paper articles and printed matter, namely, note pads, writing tablets, bookmarks, diaries, postcards, posters, self-adhesive note pads, paper, gift wrap paper, decals, stickers, stationery, stationery folders, stationery sets consisting of writing paper and envelopes, and notepads; erasers; address books and telephone number books; sketch books; pens, pencils, and decorative pencil-top ornaments; blank journals
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3532400	Application Date	10/15/2004
Registration Date	11/11/2008	Foreign Priority Date	NONE

Word Mark	ZINK. ZERO INK.
Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2008/07/06 First Use In Commerce: 2008/07/06 Printers; computer peripherals; color printers; wireless computer peripherals Class 016. First use: First Use: 2008/07/06 First Use In Commerce: 2008/07/06 Printing paper; printing media, namely digital printing paper and plastic sheets for printing

U.S. Registration No.	3525618	Application Date	11/29/2006
Registration Date	10/28/2008	Foreign Priority Date	NONE
Word Mark	ZINK ZERO INK		
Design Mark			
Description of Mark	The mark consists of a prism with colors appearing at the top magenta and purple, in the middle blue, on the outer portions gray and on the bottom, yellow and green.		
Goods/Services	Class 009. First use: First Use: 2008/07/06 First Use In Commerce: 2008/07/06 Printers; computer peripherals; color printers; wireless computer peripherals Class 016. First use: First Use: 2008/07/06 First Use In Commerce: 2008/07/06 Printing paper; printing media, namely, digital printing paper, and plastic sheets for printing		

U.S. Registration No.	3659303	Application Date	09/17/2007
Registration Date	07/21/2009	Foreign Priority Date	NONE
Word Mark	ZINK		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2008/07/06 First Use In Commerce: 2008/07/06 Printers; computer peripherals; color printers; wireless computer peripherals Class 016. First use: First Use: 2008/07/06 First Use In Commerce: 2008/07/06 Printing paper; printing media, namely, digital printing paper and plastic sheets for printing

Attachments	78500666#TMSN.jpeg ( 1 page )( bytes ) 77975953#TMSN.jpeg ( 1 page )( bytes ) 77977224#TMSN.jpeg ( 1 page )( bytes ) NGEDOCs-#1677025-v1-Notice_of_Opposition_to_Scholastic_re_MUZINK.pdf ( 6 pages )(17266 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Lawrence E. James, Jr./
Name	Lawrence E. James, Jr.
Date	12/14/2009

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<b>In the Matter of Application</b>	)	
<b>Serial No.: 77/566,527</b>	)	
	)	
<b>Published in the Official Gazette</b>	)	
<b>On June 16, 2009</b>	)	
	)	
<b>ZINK IMAGING, INC.</b>	)	
	)	
<b>Opposer,</b>	)	<b>NOTICE OF OPPOSITION</b>
<b>v.</b>	)	
	)	
<b>SCHOLASTIC, INC.,</b>	)	
	)	
<b>Applicant.</b>	)	

This Notice of Opposition is submitted in the matter of Application Serial No. 77/566,527, by which Scholastic, Inc. (“Applicant”) seeks to register the trademark MUZINK for use in connection with series of books for children in the field of music; paper articles and printed matter, namely, note pads, writing tablets, bookmarks, diaries, postcards, posters, self-adhesive note pads, paper, gift wrap paper, decals, stickers, stationery, stationery folders, stationery sets consisting of writing paper and envelopes, and notepads; erasers; address books and telephone number books; sketch books; pens, pencils, and decorative pencil-top ornaments; blank journals in International Class 16. The subject application was published for opposition in the Official Gazette on June 16, 2009. Zink Imaging, Inc., a Delaware corporation having a place of business at 16 Crosby Drive, Bedford, Massachusetts 01730, (“Zink Imaging”) believes that it would be damaged by the registration and therefore opposes the same.

The grounds for Opposition herein are as follows:

1. Zink Imaging and its predecessors own the proprietary ZINK technology that facilitates the printing of full color digital images without the need for ink cartridges or ribbons.

Since acquiring the ZINK technology in October 2005, Zink Imaging and its predecessor have operated successfully under the ZINK IMAGING trade name.

2. Long before the acts of Applicant alleged herein, Zink Imaging and its predecessors have been developing a variety of printing-related products to be marketed and sold under and in connection multiple marks comprised primarily or exclusively of the term ZINK including, without limitation, computer printers, computer peripherals, wireless computer peripherals, computer monitors, computer memory hardware, memory cards and blank magnetic data carriers. Zink Imaging and its predecessors have devoted significant resources, time and effort to developing the technology and products that are marketed and sold under the marks comprised primarily or exclusively of the term ZINK.

3. On October 15, 2004, Zink Imaging's predecessor in interest, Polaroid Corporation, filed U.S. Trademark Application Serial No. 78/500,666. On November 11, 2008, that Application was registered as U.S. Registration No. 3,532,400 for the mark ZINK. ZERO INK. for use in connection with printers; computer peripherals; color printers; wireless computer peripherals in International Class 9 and printing paper; printing media, namely, digital printing paper, and plastic sheets for printing in International Class 16. That Registration is now owned by Zink Imaging.

4. On November 29, 2006, Zink Imaging's predecessor in interest, Zink Imaging, LLC, filed U.S. Trademark Application Serial No. 77/975,953. On October 28, 2008, that Application was registered as U.S. Registration No. 3,525,618 for the mark ZINK ZERO INK and Design for use in connection with printers; computer peripherals; color printers; wireless computer peripherals in International Class 9 and printing paper; printing media, namely, digital

printing paper, and plastic sheets for printing in International Class 16. That Registration is now owned by Zink Imaging.

5. On September 17, 2007, Zink Imaging filed U.S. Trademark Application Serial No. 77/977,224. On July 21, 2009, that Application was registered as U.S. Registration No. 3,659,303 for the mark ZINK for use in connection with printers; computer peripherals; color printers; wireless computer peripherals in International Class 9 and printing paper; printing media, namely, digital printing paper and plastic sheets for printing in International Class 16, and is owned by Zink Imaging.

6. On September 10, 2008, after Zink Imaging or its predecessors filed the foregoing ZINK applications (Application Serial Nos. 78/500,666; 77/975,953; and, 77/977,224 covering goods in International Classes 9 and 16), Applicant filed an application to register the mark MUZINK based upon a purported first use in commerce of its mark on August 11, 2008, in connection with “series of books for children in the field of music; paper articles and printed matter, namely, note pads, writing tablets, bookmarks, diaries, postcards, posters, self-adhesive note pads, paper, gift wrap paper, decals, stickers, stationery, stationery folders, stationery sets consisting of writing paper and envelopes, and notepads; erasers; address books and telephone number books; sketch books; pens, pencils, and decorative pencil-top ornaments; blank journals” in International Class 16.

7. On June 16, 2009, Applicant’s mark published for opposition. On July 16, 2009, Zink Imaging filed a timely request for a 90 day extension of time in which to oppose the subject application, which was granted by the Trademark Trial and Appeal Board in its July 16, 2009 Order. On October 12, 2009, Zink Imaging filed a timely request for a 60 day extension of time

in which to oppose the subject application with Applicant's consent, which was granted by the Trademark Trial and Appeal Board in its October 12, 2009 Order.

8. By virtue of its ZINK trademark applications filed long before August 11, 2008, Zink Imaging is the constructive prior user of the ZINK, ZERO INK., ZINK ZERO INK and Design and ZINK marks and has priority over Applicant's use of the subject mark.

9. Zink Imaging is concerned that Applicant's mark comprised of the term MUZINK is likely to cause confusion or mistake, or deceive purchasers, in that purchasers would be likely to believe that the goods covered by Applicant's application are Zink Imaging's goods, or are in some way legitimately connected with, sponsored by or approved by Zink Imaging. Zink Imaging is likewise concerned that Applicant's registration of its mark would result in damage to Zink Imaging, and on that basis, Zink Imaging opposes registration of Applicant's mark.

WHEREFORE, Zink Imaging requests that the registration sought by Applicant be refused and that this Notice of Opposition be sustained.

Zink Imaging requests that the requisite filing fee of \$300.00 be charged to the deposit account of Neal, Gerber & Eisenberg LLP, Account No. 502261.

Please address all communications to Lee J. Eulgen and Lawrence E. James, Jr., Neal, Gerber & Eisenberg LLP, 2 North LaSalle Street, Suite 2200, Chicago, Illinois, 60602.

Respectfully submitted,

Date: December 14, 2009

By: /Lawrence E. James, Jr./  
One of the Attorneys for Opposer,  
Zink Imaging, Inc.

Lee J. Eulgen  
Lawrence E. James, Jr.  
Neal, Gerber & Eisenberg LLP

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Chicago, Illinois 60602-3801  
(312) 269-8000



## **CERTIFICATE OF SERVICE**

I, Lawrence E. James, Jr., an attorney, state that, pursuant to 37 CFR §§ 2.101 and 2.119,

I caused a copy of the foregoing Notice of Opposition to be served upon:

Scholastic Inc.  
557 Broadway  
New York, New York 10012

And  
Edward H. Rosenthal  
Frankfurt Kurnit Klein & Selz PC  
488 Madison Avenue  
New York, New York 10022

Via U.S. Mail, first class, postage prepaid on December 14, 2009.

/Lawrence E. James, Jr./  
Lawrence E. James, Jr.